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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/844,322 04/26/01 NORMAN

C 1391-CON-00

EXAMINER

FRANCIS, F

ART UNIT	PAPER NUMBER
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3712

3

DATE MAILED: 08/07/01

QM32/0807
SCHNADER HARRISON SEGAL & LEWIS LLP
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PHILADELPHIA PA 19103-7286

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in page 1 line two, -- PAT 6,227,930 -- should be added after "1998".

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide antecedent basis for the phrase "the stress which result in a 100% strain of the material" in lines 1 and 2 of the claim 31.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ribbon and the bow in claims 23 and 29, the rock, the flames, the bones, the second skins, animals and creatures in claim 24 and the suit, the shorts the cloak, the cape, the uniform, the shoes, the helmet, the armor, scarf and lapel in claims 25 and 29 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

4. Claims 19-37 are objected to because of the following informalities: the claims 19-37 depend on claims 1-3, 12 and 16-17 that have been cancelled by the applicant in the Preliminary Amendment filed on 4/26/01. For the purpose of this office action the claims 19, 21-26, 28 and 31-32 in the case are considered to depend on claim 18, claim 20 is considered to depend on claim 19, claim 27 is considered to depend on claim 26, claim 29 is considered to depend on claim 20, claim 30 is considered to depend on claim 29, claim 34 is considered to depend on claim 33 and claim 35 is considered to depend on claim 34. However, clarification of the scope of the claims is required in response to this office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 18-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., new matter.

Art Unit: 3712

The specification as originally filed does not provide support for the teaching of thermoplastic elastomer as now recited in claims 18 and 33. Also the specification does not provide support for the animals, and creatures in claim 24, a suit, shorts, shoes, a helmet and armor in claims 25 and 29 and a ribbon, a bow, a lapel, shorts as now recited in claim 29, " the stress which results in a 100% strain of the material " in claim 30 and " the stress which results in a 300% strain of the material" as now recited in claim 31. Accordingly these limitations now added to the claims are considered to be New Matter. Applicant is required to cancel the new matter in the response to this office action.

7. Claims 30-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear what the applicant refers to as " the stress which results in a 100% strain of the material" and " the stress, which results in a 300% strain of the material".

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 19, 24 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 19: the scope of the claim is unclear because of the improper use of the Markush group, reciting members as being "selected from the group consisting of A, B and C" See EX parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).

With respect to claim 24: it is not clear how the doll's garment simulates a rock, flames, bones, second skins, animals, and creatures.

With respect to claim 30-31: the phrases " the stress which results in a 100% strain of the material is between 240 and 280 KN/m²" and " the stress which results in a 300% strain of the material is between 440 and 490 KN/m²" are confusing.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 18-20, 23-25, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Yasuda.

Yasuda discloses a doll's garment [col 19, 2nd line from the bottom] formed from an injection molded [col 5 line 42] thermoplastic [claim 8] elastomer as recited in claim 1, wherein the thermoplastic elastomer is containing styrene [col 3 lines 18-54] as

Art Unit: 3712

recited in claims 19-20 and the garment includes a ribbon [col 19 last line] [claims 23 and 29].

Moreover the limitations in claims 24-25 and 29 are presumed to be inherent in the device of Yasuda [col 19 last paragraph and col 20 first paragraph].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 21-22, 26-28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda.

Yasuda discloses most of the features of these claims as applied to claims 18-20, 23-25, and 29 including the injected molded thermoplastic elastomer are colorless [transparent, col 4 line 6] [claim 27], but does not disclose the garment has a wall thickness from 1 to 3 mm [claim 21], the thermoplastic elastomer has an average modulus of elasticity of less than 1MN/m² [claims 22 and 30], a finish selected from the group consisting of paint, varnish, and glitter[claim 26] and the garment is less than 8 cm in height [claim 28].

With respect to claim 21, it would have been obvious to provide the garment of Yasuda in the claimed thickness for the purpose of making the devices easier to play with.

With respect to claims 22 and 30, it would have been obvious to construct the device of Yasuda to have the claimed average modulus of elasticity for the purpose of having good elasticity and deformability.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to modify the Yasuda's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to provide the garment of Yasuda in the claimed height for the purpose of making the devices easier to play with.

14. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of Gross.

Yasuda discloses most of the features of these claims as disclosed above in paragraph 11, but does not disclose a play set comprising a doll [claim 33] wherein doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips [claim 34].

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garment wherein doll is articulated at elbows and knees. It would have been obvious to provide the device of Yasuda with the doll disclosed by Gross, for the

Art Unit: 3712

purpose of making the device more enjoyable for the children to play with by having a complete set [doll and the doll's garment].

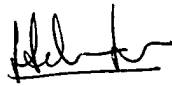
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is (703)306-5941. The examiner can normally be reached on 6:30 AM - 3:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacob Ackun can be reached on (703) 308-3867. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

FF
August 2, 2001


JACOB K. ACKUN, JR.
SUPERVISORY PATENT EXAMINER
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